

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISAYOSHI TSUBAKI, MIKIO WATANABE,
and HIROSHI TANAKA

Appeal 2007-0932
Application 10/058,924
Technology Center 2600

Decided: July 11, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON,
and ALLEN R. MACDONALD, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 41. We have jurisdiction under
35 U.S.C. §§ 6(b) and 134(a).

As best representative of the disclosed and claimed invention,
independent claim 1 is reproduced below:

1. An image recording method, comprising:
an information loading step of loading identification information on a subject and subject information used by a photographer to confirm an identity of the subject, in a digital camera before photographing the subject;

a display step of displaying, on the basis of the subject information, subject information used by the photographer to confirm the identity of the subject on a display device of the digital camera before photographing the subject;

a photographing step of photographing the subject using the digital camera after confirming the identity of the subject on the basis of the subject information displayed on the display device; and

a recording step of recording the photographed image of the subject in connection with the identification information loaded in the information loading step.

The following references are relied on by the Examiner:

Allen	US 5,737,491	Apr. 7, 1998
McDonald	US 5,920,317	Jul. 6, 1999
Wang	US 6,038,333	Mar. 14, 2000
Kuperstein	US 6,128,398	Oct. 3, 2000

Core Bibliographic information in the TIFF header (TIFF),
http://gdz.sub.uni-goettingen.de/en-old/tech_notes/tiffheader.html (last visited May 26, 2005).

Claims 1 through 41 stand rejected under 35 U.S.C. § 103. In a first stated rejection, the Examiner relies upon McDonald in view of Wang as to claims 1 through 3, 12, 37, 38, and 40. In a second stated rejection, the Examiner adds TIFF as to claims 4, 11, and 13. As to claims 5 through 7, 9, 10, 15 through 17, 19 through 21, and 39, the Examiner relies upon

McDonald in view Wang, further in view of Kuperstein. In a fourth stated rejection as to claims 8, 18, and 22, to this latter combination of references the Examiner again adds TIFF. The Examiner utilizes Allen alone as to claims 14 and 23 through 36 in a fifth stated rejection. Lastly, in a sixth stated rejection, the Examiner relies upon McDonald in view of Wang, further in view of Allen, as to claim 41.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for the Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

Generally, for the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain each of the six stated rejections of the claims on appeal rejected under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1996). “[T]he Examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.3d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise

teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

The Examiner’s reasoning set forth in the Answer as buttressed by the following remarks meet the rational underpinnings required by the above-noted case law. Moreover, to the extent Appellants have not presented arguments to us in the Brief and Reply Brief as to any claimed feature and any claim, they are considered to have been waived.

Initially, we make note of Appellants’ assessment of the prior art at Specification pages 1 and 2. It was recognized there that a patient’s ID number may be inputted from a keyboard connected to a digital camera thus permitting the creation of a later photographic image of the patient in conjunction with the patient’s ID within a given data folder. Additional information, such as that set forth in the latter independent claims on appeal, was known to be recorded on mediums in connection with a photographed image of a patient to permit a photographer to check or otherwise “confirm” previously entered patient information such as an ID number and image before the subsequent photographic operation. It is this not entirely clear to us what contribution in the art is recited in the argued independent claims on appeal.

With respect to apparatus independent claims 15, 19, and 36, the Examiner observes each of these claims is directed toward an apparatus and that each claim must be distinguished from the prior art in terms of structure

rather than function. The Examiner relied upon *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). We agree with the Examiner's reliance upon this precedent as indicating that it is well settled that the recitation of a new and intended use for an old product does not make a claim to that old product patentable. The Examiner, of course, is referring to the potential future use of the confirmation process of the identity of a subject person to be photographed by the photographer, a feature which was known in the art anyway according to Appellants' admissions thereof as noted earlier in this opinion.

Turning to the first stated rejection, Appellants present arguments only as to independent claim 1 among the claims rejected here. These arguments are presented in the principal Brief on appeal between pages 20 and 26, and between pages 18 and 20 in the Reply Brief in a repetitive manner.

The Examiner's rationale at page 5 of the Answer indicates that McDonald does not explicitly disclose the feature of displaying the subject information on a display device of the digital camera, a feature the Examiner subsequently relies upon Wang to teach. Contrary to the positions set forth in the Brief and Reply Brief, the emphasis in the statement of the Examiner is not upon the word "not" but upon the word "explicitly." As the record reveals, the digital camera of McDonald is the ultrasound image capture station 22 in figure 1. The demographic data module within each capture station 22 and review stations 26 in figure 1 retrieve their pre-entered data from the database server 24. The description of the nature of the entry of information in this module is discussed at columns 4 and 5 of McDonald to

include the claimed patient identification information of a subject as well as so-called subject information that may be used by a photographer.

A key to understanding the nature of McDonald are the statements at column 4, lines 47 through 55, and the additional statements at column 5, lines 1 through 8. The system 20 in figure 1 is stated to include all functionality necessary to identify a patient *before* an ultrasound imaging scan is to take place *after* the creation of an admission record for the patient. The emphasis is upon the hospital facility maintaining impeccable records to identify and track subsequent ultrasound scans to ensure that each scan is accurately associated with a specific patient and on a specific date. This emphasis is focused upon the accuracy and the correct association of each image scanned with each patient. Thus, the demographic data module is stated to be included, as shown in figure 1, in each capture station 22 and review station 26. Each review station 26 includes the capability for reviewing a pre-scanned image according to the discussion beginning at column 9, and to do so upon a display device or computer display associated with each module.

Because the demographic data module is included within image capture station 22, it is only by inference rather than explicitly disclosed in McDonald as the Examiner indicates in the rejection, that the earlier-noted key patient information is interpreted by the artisan to be displayed to the operator before the ultrasound scan occurs. Additionally, it is noted at the bottom of column 3 that the figure 1 system 20 includes client machines 22, 26 each of which comprise personal computers which have the earlier-noted image display associated with them. The discussion beginning at the middle

of column 4 indicates the display of video information from an image scan on a computer monitor display of this computer. Figure 8 of McDonald indirectly shows a similar teaching by the automatic generation of a clinical report by the system which identifies the patient; a similar teaching occurs indirectly as well by the showing of the ultrasound image review screen in figure 5.

The artisan would thus appreciate that the additional evidence provided by Wang merely is more explicit than that which have been identified by the Examiner and emphasized by us here in McDonald to begin with. An image of a person and associated ID information is depicted in Wang in figures 2 and 3A, the image which is derived according to the digital camera 23 in figure 3B as a part of the system 20 also shown in figures 2 and 3A. The system in figure 5 is depicted to indirectly show the display 53 and camera 52 which is connected to the user interface 41 in figure 4 which comprises in part the analysis system 12 in figure 1. Figure 4 and Figure 1 both show the profile database associated with the imaged person and the associated data as noted earlier. Wang merely shows what McDonald indirectly indicates to the artisan and depicts what Appellants have appeared to have admitted in the prior art anyway as discussed earlier. Although we recognize that the Examiner's motivation of combinability of Wang's teachings and showings to those of McDonald is rather weakly based (Answer 5), such as to create a portable handheld device, the actual teachings and showings of the respective references are more compelling of the obviousness than the Examiner appears to appreciate.

Therefore, Appellants' arguments noted earlier in the Brief and Reply Brief as to this rejection are misplaced. Appellants repeatedly argue the non-combinability of the central database of McDonald with the decentralized system of Wang. The Examiner is correct in the observation at page 21 of the Answer that the claims are properly rejectable within 35 U.S.C. § 103 which requires the consideration of the combined teachings of the respective references rather than the physical combination of the structures taught in them. Moreover, the artisan may well consider the teachings in Wang to be centralized in the same way Appellants characterize McDonald due to the label of a profile database 13 in figure 1 and the characterization of the nature of the overall system beginning at figure 1 and discussed at the top of column 4.

In any event, the digital camera, ultrasound digital image capture system 22 in figure 1 of McDonald, contains demographic information in the same manner it is permitted to be displayed within the system 20, which includes a digital camera, of Wang. The discussion of the earlier figures of Wang at column 8 merely identifies the ability of the personal identifier and management system 10 of figure 1 to be within a portable personal system depicted in figures 3A and 3B. What is significant is that both references teach that identifying information contained within a given device relative to a person is contained within the respective devices themselves. Rather than arguing against the combinability of McDonald's and Wang's teachings, Wang does more particularly identify that image data may be associated with otherwise text entered data of a person for identification purposes even though representative independent claim 1 on appeal does not require the

display of image data relative to a person as a part of the identifying information and the subject information.

Therefore, the artisan would well appreciate that the teachings of Wang would have made even more accurate and permanent and impeccable the patient ID information in McDonald than is required according to the teachings we identified earlier at columns 4 and 5 of that reference. The Reply Brief, which merely repeats the arguments in the Brief in an unpersuasive manner, fails to address the Examiner's indication at page 21 of the Answer that it is the combined teachings of the references that are key to a proper combinability analysis within 35 U.S.C. § 103 and not any physical or structural combinability.

As to the second stated rejection of claims 4, 11, and 13, Appellants rely for patentability upon the arguments presented with respect to independent claim 1 according to the arguments regarding the second stated rejection at pages 26 and 27 of the principal Brief on appeal. Appellants do not contest here the Examiner's reliance upon and the teachings of TIFF, alleging only that the deficiencies of McDonald and Wang are not made up for by this latter reference. The rejection of these claims is therefore affirmed.

Turning to the third stated rejection where the Examiner relies upon McDonald in view Wang, further in view of Kuperstein, Appellants present arguments at page 27 with respect to this rejection. Again, Appellants argue for patentability of claims 5 through 7, 9, 10, and 39 based upon the arguments presented with respect to independent claim 1 and not for any particular features recited in claim 5, for example, among these claims.

Likewise, the mere assertion is made that Kuperstein does not make up for the deficiencies of McDonald and Wang as to claim 1. No arguments are presented per se as to independent claims 15 and 19 within this stated rejection. The rejection of all these claims in the third stated rejection is sustained.

Appellants present arguments at pages 28 and 29 of the principal Brief on appeal as to the fourth stated rejection of dependent claims 8, 18, and 22 where the Examiner relies upon McDonald in view of Wang, further in view of Kuperstein and TIFF. It is noted that the subject matter of dependent claims 8, 18, and 22 is substantially the same as or identical to the subject matter of dependent claims 4, 11, and 13, which have not been argued by Appellants in the second stated rejection as we noted earlier in this opinion. The assertion that the Examiner has not provided any evidentiary bases for motivation to reject claims 8, 18, and 22 belies an understanding of the record before us. Contrary to the assertion made at page 28 of the principal Brief on appeal – fifth, there is no requirement that an explicit motivation be found within the cited references per se, even though we have buttressed the Examiner's positions earlier with respect to the combinability of McDonald and Wang anyway. The mere dependency of claims 8, 18, and 22 from independent claims 1, 15, and 19 is argued in effect as a basis for patentability based upon the features recited in those independent claims. Appellants have presented no arguments to us as to any feature recited in these dependent claims or otherwise contest the applicability of the respective teachings of Kuperstein and TIFF the Examiner relies upon to add to those of McDonald and Wang. Moreover, no arguments have been

presented to us, as noted earlier, as to independent claims 15 and 19 anyway. The Reply Brief does not contest the Examiner's remarks with respect to the rejection of claims 8, 18, and 22 made at pages 21 and 22 of the Answer.

We further note here that the ultrasound image capture module of figure 1 of McDonald is discussed at columns 5 through 8 noting that certain descriptor fields for annotated information are recorded together with the image itself by means of the MPEG encoding system utilized in McDonald. The Examiner has provided evidence in TIFF that it was well-known to provide image description information, document name information as well as the actual image, together in the header of an analogous TIFF format imaging coding approach. It is this concept of recording image identification information associated with the image format recording technique itself that is the basis for the Examiner's rejection and the un-rebutted responsive remarks at pages 21 and 22 of the Answer.

Next we treat the fifth stated rejection of claims 14 and 23 through 36 (including independent claims 14, 23, and 36) as being obvious over Allen alone. Allen is also relied upon in addition to McDonald and Wang as to independent claim 41 in a sixth stated rejection.

In formulating the rejection of independent claims 14, 23, 36, and 41, the Examiner recognizes that these claims require the input of destination information in a digital camera utilized before the photographing act itself occurs. The Examiner's basic position considers that it would have been obvious to have performed this act of data entry before the actual photography based upon a design choice analysis even though the Examiner recognizes that Allen alone or together with the other references would

appear to teach the entry of the destination information after the step of photographing the subject. Along with this reasoning, the Examiner asserts the absence of criticality of the order in which these acts occur.

The Examiner repeats the design choice line of reasoning in the responsive arguments as to these independent claims at pages 22 and 23 of the Answer.

Beginning at page 29 of the principal Brief on appeal and page 20 of the Reply Brief, Appellants assert there is criticality according to the order in which the acts are claimed to occur based upon the disclosed invention.

Although we sustain the rejection of the claims in the fifth and sixth stated rejections, we consider the Examiner's reliance upon design choice of the order of presentation to be in effect a per se rule of unpatentability. The skilled artisan may well consider Appellants' arguments of criticality to be persuasive. On the other hand, we understand the teachings and showings of Allen to clearly indicate to the skilled artisan that the entry of destination information does occur before the act of photography itself in Allen. In figure 1, the voice recognition module 30 includes the code book 25. It is clear from the discussion at column 2, line 52 through column 3, line 4 that electronic address information may be entered into this code book by the use of an LCD touch screen or the microphone 24. The figure 2 showing of the "compare" capability in block 58 of this flow chart compares later, after the photography act has occurred, verbal identity or selection of preentered destination information in accordance with the discussion at column 3, line 49 through column 4, line 20 and the discussion at column 4, lines 40 through 54. It is clear from this overall discussion in Allen that the compare

function in block 58 of figure 2 relies upon for comparison purposes information pre-entered before the act of photography itself is said to occur or illustrated to occur in figure 2. The arguments with respect to independent claim 41 at pages 32 and 33 of the principal Brief on appeal rely for patentability upon the arguments presented with respect to independent claim 1. We note here as well that McDonald clearly teaches the pre-entry of information before the image capture act occurs. Correspondingly, no arguments are presented in the Reply Brief as to claim 41.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 41 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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